

## REMARKS/ARGUMENTS

### **Claim Status**

Claims 1 and 4-20 are pending. The pending claims are rejected as follows: (i) claims 1, 4, 5 and 8-19 are rejected as anticipated by *Haeberle et al.* (US 5,387,367); (ii) claims 1, 4-6 and 8-19 are rejected as obvious in view of *Haeberle et al.* and *Morikawa et al.* (US 5,652,300); and (iii) claims 7 and 20 are rejected as obvious in view of *Haeberle et al.*, alone or in combination with *Morikawa et al.*, and *Weyland et al.* (US 5,587,421). Applicants respectfully traverse these rejections.

### ***Haeberle* is Not Anticipatory of Applicants' Claims**

The Office has asserted the following:

- 1) *Haeberle*'s reaction product b) corresponds to Applicants' component (C) which can be calculated to be 16-17 weight % as disclosed in Examples 1-10 and 12, or can be 10 weight % as disclosed in Example 11 (Office Action: page 3, line 15, to page 4, line 2); and *Haeberle*'s polyisocyanate a) corresponds to Applicants' components (A)+(B) (Office Action: page 3, line 16).
- 2) Given the 10 or 16-17 weight % values for (C), one can then calculate (A)+(B) to be 90 or 83-84 weight % respectively, which in turn can give 45 or 41.5-42 weight % for each of (A) and (B) separately because "one would have immediately envisioned polyisocyanate component amounts of the blend, such as 50:50 mixtures" (Office Action: page 4, lines 5-13).

However, Applicants note that "immediately envision" is not the standard of proof with respect to anticipation of claimed limitations. Applicants point out that the correct standard of proof is recited in M.P.E.P. 2131 which states: "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Therefore, if "immediately envision" is indeed the position the Examiner is taking, Applicants respectfully request the withdrawal of this

rejection based on the use of an improper standard with respect to a rejection based on anticipation.

If instead, the Examiner is taking the position that *Haeberle et al.* inherently discloses mixtures that fall within the weight % limitations of Applicants (A) and (B) as claimed, Applicants point out that M.P.E.P. 2112 (Part IV) states:

“The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. ... To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.”

Thus, the Office has not met its burden of proof with respect to the alleged inherent characteristics of *Haeberle et al.*'s mixtures, namely the weight % of (A) and (B) as depicted in Applicants' claim 1. Furthermore, the Examiner has admitted that “the examples [of *Haeberle et al.*] do not disclose mixtures of polyisocyanate a)” immediately after discussing the envision/inherency of such mixtures. This in and of itself indicates, at the very least, uncertainty with respect to the disclosure of *Haeberle et al.* which can be construed to be equivalent to the term “may” as quoted above instead of the required certainty and necessity as described below. Accordingly, since *Haeberle et al.* do not disclose formulations that meet all three claimed weight % ranges of Applicants' claim 1, *Haeberle et al.* cannot be considered anticipatory.

Furthermore, even if one skilled in the art were to prepare a 50:50 blend of *Haeberle et al.*'s components as “envisioned” by the Examiner, one would obtain a highly viscous blend which would be difficult to emulsify without the addition of solvent to reduce the viscosity prior to emulsification. Therefore, one skilled in the art, after obtaining such a highly viscous 50:50 blend, would have the impression that such a blend would not be

emulsifiable. Accordingly, one skilled in the art would recognize two problems associated with emulsifying such a highly viscous mixture in water: (1) the high viscosity would render the mixture virtually non-emulsifiable, and (2) due to such extremely slow emulsification, water would react with the highly reactive NCO-groups present, which in turn would increase the viscosity even further. Therefore, one skilled in the art would not consider (or “immediately envision”) using a 50:50 blend as discussed above.

Accordingly, the disclosure of *Haeberle et al.* neither inherently discloses, nor allows one to immediately envision, the mixture of claimed components and their respective weight percents as claimed by Applicants. Thus, *Haeberle et al.* is not anticipatory.

#### ***Haeberle and Morikawa Do Not Render Obvious Applicants’ Claims***

The Office asserts that *Morikawa et al.*’s disclosed range of HDI:IPDI being 95:5 to 35:65 (see col. 5, lines 25-30) corresponds to Applicants’ weight percent ratio of (A):(B) being 95:5 to 33:67; as calculated by the Examiner from the claimed weight % limitations of claim 1 (Office Action: page 6, lines 5-9). The Examiner has concluded that even if *Haeberle et al.* were considered insufficient by itself to anticipate the weight % limitations of (A) and (B), the incorporation of *Morikawa et al.* fulfills this deficiency. Applicants disagree.

*Morikawa et al.* disclose, for example, isocyanates that are low viscous urethanes built from diols and polyisocyanates containing uretdione groups, to give a modified HDI with a viscosity of 99 cP/25°C and an NCO functionality of 2.3 (col. 10, line 50, to col. 11, line 10). Furthermore, this modified HDI is mixed with a modified IPDI to give a polyisocyanate mixture having a viscosity of 810 cP/25°C and an NCO functionality of 2.4 (col. 12, lines 32-46). The Examiner equates this resulting polyisocyanate mixture of *Morikawa et al.* to Applicants’ (A)+(B) which is equated to *Haeberle*’s polyisocyanate a).

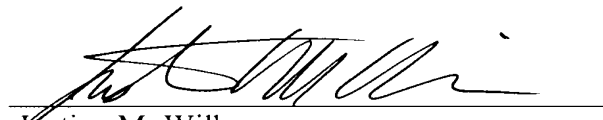
However, *Haeberle*'s polyisocyanate a) has an NCO functionality of 2.5 to 3.5 (col. 2, lines 54-61). Accordingly, given the differences in desired viscosity and NCO functionality, one skilled in the art would not combine the disclosures of *Haeberle* and *Morikawa*. What's more and for the same reasons, one skilled in the art would not consider the weight % ratios of HDI:IPDI in *Morikawa* combinable with the disclosure of *Haeberle* to fulfill the weight % deficiencies of *Haeberle* as alleged by the Examiner. Therefore, one skilled in the art would lack the motivation to combine such a single specific parameter from *Morikawa et al.* (i.e., ratio of A to B) to the disclosure of *Haeberle et al.* as a whole. Thus, without motivation to combine, the combination of *Haeberle* and *Morikawa* does not disclose or suggest Applicants' claims.

### Conclusion

For the reasons discussed above, Applicants submit that all now-pending claims are in condition for allowance. Applicants respectfully request the withdrawal of the rejections and passage of this case to issue.

Respectfully submitted,

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